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PATENT

Attorney Docket No. 09812.0443-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Sumio IWASE) Group Art Unit: 3693
)
Application No.: 09/869,993) Examiner: Sara M. Chandler
)
Filed: October 15, 2001)
)
For: AUCTION SYSTEM, AUCTION) Confirmation No.: 4325
PROCESSING APPARATUS,)
AUCTION PROCESSING)
METHOD, AND INFORMATION)
PROCESSING SYSTEM AND)
METHOD OF SAME)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement mailed April 13, 2010, the period for response to which is July 13, 2010, the Examiner required restriction under 35 U.S.C. § 121 between the following groups of claims :

- Group I - Claims 1-6, characterized by the Examiner as being drawn to an auction system for carrying out an auction in a network.
- Group II - Claims 7-10, characterized by the Examiner as being drawn to an auction processing method for hosting an auction in a network.
- Group III - Claims 11-18, characterized by the Examiner as being drawn to an auction processing apparatus connected to a network and receiving a bid transmitted from any node via said network.
- Group IV - Claim 19, characterized by the Examiner as being drawn to an auction processing method for receiving a bid transmitted from any node via

a network and hosting an auction of a desired product in an apparatus connected to a network.

Group V - Claims 20 and 21, characterized by the Examiner as being drawn to an auction processing apparatus for submitting a product for auction to a system disclosing information describing products and hosting auctions with respect to the products on a network.

Group VI - Claims 22-23, characterized by the Examiner as being drawn to an auction processing method for submitting a product for auction to a system disclosing information describing products and hosting auctions for related products on a network.

Group VII - Claims 24-34, characterized by the Examiner as being drawn to an auction system for hosting auctions in a network.

Group VIII - Claims 35-41, characterized by the Examiner as being drawn to an auction processing method for hosting an auction in a network.

Group IX - Claims 42-50, characterized by the Examiner as being drawn to an auction processing apparatus having a shipping information requesting means connected to a network.

Group X - Claims 51 and 52, characterized by the Examiner as being drawn to an auction processing apparatus/method connected to a network and hosting an auction of any product.

Group XI - Claims 53-57, characterized by the Examiner as being drawn to an information processing system.

Group XII - Claims 58-62, characterized by the Examiner as being drawn to a second step of raising a suit with respect to said service by transmitting petition information to a trial processing side.

Applicant provisionally elects to prosecute Group V, claims 20 and 21, with traverse.

Applicant respectfully traverses the restriction requirement between Groups V and VI because the subject matter of the claims within these groups overlaps to such an extent that examination of both groups of claims would not present a serious burden on

the Examiner. See M.P.E.P. § 803 ("There must be a serious burden on the examiner if restriction is required.").

Although the Examiner believes that the system of Group VI has separate utility, (see Office Action, page 5-6), Applicant asserts that examination of Groups V and VI would not present a serious burden on the Examiner. For example, a proper search for the subject matter of Group V would at least partially overlap with a proper search for the subject matter of Group VI. Group V is directed to an "auction processing apparatus for submitting a product for auction to a system disclosing information describing products and hosting auctions with respect to the products on a network," as recited in claim 20. Group VI is directed to an "auction processing method for submitting a product for auction to a system disclosing information describing products and hosting auctions for related products on a network," as recited in claim 22. Moreover, a proper search for the subject matter of Group VI would reasonably include at least some of the subject matter of Group V. That overlap between the searches highlights the lack of a serious burden on the Office to consider both groups of claims in this application. Applicant therefore respectfully requests that the restriction requirement be withdrawn.

As stated in M.P.E.P. § 803, "[i]f the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (emphasis added). As previously stated, the Examiner has not shown there would be a serious burden to examine all of the claims recited in Groups V and VI. Indeed, as a proper search of the subject matter of the claims of any of these groups would necessarily include a search of the subject matter of the claims of the other groups, the Examiner

cannot show there would be a serious burden to search and examine all of the pending claims.

Finally, it is also noted that this application was filed under 35 U.S.C. § 371, thus rendering applicable unity of invention practice. See M.P.E.P. § 1893.03(d) ("Examiners are reminded that unity of invention... is applicable... in national stage applications submitted under 35 U.S.C. § 371"). And as described *supra*, Groups V and VI share common elements, as they are both directed to submission of a product for auction to a system disclosing information describing products and hosting auctions. Therefore, these groups share a special technical feature and possess the requisite unity of invention. Applicant thus respectfully submits that the restriction requirement between Groups V and VI is in error. For at least the forgoing reasons, Applicant respectfully requests withdrawal of the restriction requirements asserted in the April 13, 2010 Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 13, 2010

By: /David W. Hill/
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